Response Under 37 C.F.R. 1.116
Applicant: Michael J. Brosnan
Serial No.: 09/811,001
Filed: March 13, 2001
Docket No.: 10010038-1
Title: PORTABLE ELECTRONIC DEVICE WITH MOUSE-LIKE CAPABILITIES

REMARKS

This Response is responsive to the Final Office Action mailed January 28, 2005. In that Office Action, the Examiner rejected claims 1, 2, 4-7, and 10 under 35 U.S.C. §102(a) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over, Paloniemi, U.S. Patent Publication No. 2001/0017934 ("Paloniemi"). Claims 11, 13-15, 18, 19, and 22 were rejected under 35 U.S.C. §102(a) as being anticipated by Paloniemi. Claims 3, 8, 9, 12, 16, 17, 20, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paloniemi in view of Gordon et al., U.S. Patent No. 6,057,540 ("Gordon").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1-22. Claims 1-22 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §§102, 103 Rejections

The Examiner rejected claims 1, 2, 4-7, and 10 under 35 U.S.C. §102(a) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over, Paloniemi, U.S. Patent Publication No. 2001/0017934 ("Paloniemi"). Independent claim 1 recites "generating a second set of movement data with the motion detection device indicating an amount and direction of a second relative movement between the portable electronic device and the imaging surface", and "selecting the first menu item based on the second set of movement data." Independent claim 5 recites "the motion detection device . . . configured to generate a second set of movement data indicating an amount and direction of a second relative movement between the portable electronic device and the imaging surface" and "the controller configured to select the first menu item based on the second set of movement data." The Examiner stated that:

> Although Paloniemi, in Para. [0032], suggests the use of a finger tap motion for performing a menu item selection; Clearly, one skilled in the art could use any of the left and right motions instead of the tap motion for performing a menu item selection; because this would provide convenient data input, allow more flexibility in choosing movement data for input control, and enhance the usability of the portable electronic device. (Office Action at para. no. 3, page 3).

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As indicated by the above quote, the Examiner appears to have acknowledged that Paloniemi does not teach or suggest selecting a highlighted menu item based on movement data as recited in claims 1 and 5. The Examiner's unsupported speculation regarding what one skilled in the art "could" do, does not establish a *prima facie* case of obviousness. One of the requirements of establishing a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. Paloniemi discloses that selections are made with "a selection button or key", or by a "finger tap, to the fingerprint sensor". (Paloniemi at page 3, para. nos. 31 and 32). There is no teaching or suggestion in Paloniemi that any movement data is generated in response to pressing a selection button or key, or tapping the fingerprint sensor, let alone movement data that indicates "an **amount and direction** of a second relative movement between the portable electronic device and the imaging surface," as recited in claims 1 and 5. If no such movement data is generated, it logically follows that Paloniemi also does not teach or suggest selecting a highlighted menu item "based on" such movement data as recited in claims 1 and 5.

Since Paloniemi does not teach or suggest each and every limitation of claim 1 and claim 5, it is not clear if the Examiner is relying on Official Notice, or the concept of inherency, in the rejection of these claims. However, as indicated in the Manual of Patent Examining Procedure, "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known." MPEP § 2144.03(A). "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known." *Id.* (emphasis in original). The limitations in claims 1 and 5 that the Examiner appears to have acknowledged are not explicitly taught or suggested by Paloniemi are not well known facts that are capable of instant and unquestionable demonstration as being well known, and it would be inappropriate to simply rely on official notice in this case.

It is also not inherent in Paloniemi that a highlighted menu item is selected based on movement data as recited in claims 1 and 5. As the Federal Circuit has stated, "[i]nherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely

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probably or possibly present, in the prior art." *Trintec Indus., v. Top-U.S.A. Corp.*, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Since the selection of a menu item in Paloniemi can be made without generating movement as recited in claims 1 and 5, it is not inherent in Paloniemi that a highlighted menu item is selected based on movement data.

In view of the above, independent claims 1 and 5 are not taught or suggested by Paloniemi. In addition, dependent claims 2, 4, 6, 7, and 10, which further limit patentably distinct claim 1 or claim 5, and are further distinguishable over the cited reference, are also believed to be allowable over the cited reference. Allowance of claims 1, 2, 4-7, and 10 is respectfully requested.

The Examiner rejected claims 11, 13-15, 18, 19, and 22 under 35 U.S.C. §102(a) as being anticipated by Paloniemi. Independent claims 11, 14, and 18, each include the limitations "storing movement pattern data representing a first pattern of relative movement between the portable electronic device and an imaging surface", "generating a first set of motion data" the first set of motion data "representing a second pattern of relative movement between the portable electronic device and an imaging surface", and "comparing the first set of motion data to the stored movement pattern data". The Examiner stated that:

> Paloniemi further also teach the use of a memory 9 for storing an image of the authorized user's fingerprint, which is a pattern of ridges and valleys that lie across the surface of a user's fingertip detected by the fingerprint sensor 5, and that is read on "a first pattern of relative movement between the portable electronic device and an image surface; see Para. [0022]; and a controller 3 for comparing the image of the user's fingerprint generated when "the user swipes his fingertip over the fingerprint sensor 5" and the stored authorized user's fingerprint (the authorized user's fingerprint) for identifying the user of the portable electronic device; see Para. [0022] and [0032]. (Office Action at para. no. 6, pages 3-4).

Applicant respectfully disagrees with the Examiner's conclusion that storing an image of a user's fingerprint somehow teaches or suggests "storing **movement pattern** data representing a first **pattern of relative movement** between the portable electronic device and an imaging surface". The "pattern of ridges and valleys", as stated by the Examiner, of the fingerprint image, is not a movement pattern, nor does the fingerprint image represent a pattern of relative movement between a portable electronic device and an imaging surface.

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Applicant also respectfully disagrees with the Examiner's conclusion that comparing a fingerprint image with a stored authorized fingerprint image somehow teaches or suggests "comparing the first set of **motion** data to the stored **movement pattern** data". Neither fingerprint image is motion data, and neither fingerprint image is movement pattern data.

Paloniemi does not teach or suggest identifying a user, or enabling operation of a portable electronic device, based on a comparison of stored movement pattern data representing a first pattern of relative movement with a set of motion data representing a second pattern of relative movement. Rather, Paloniemi discloses that, in a "fingerprint input mode", an image of a user's fingerprint is formed, and this image is then compared to a stored fingerprint image. (See, e.g., Paloniemi at page 3, para. no. 32). If the images match, the device switches to a "motion input mode". (See, e.g., Paloniemi at page 3, para. no. 32). The disclosure in Paloniemi that two fingerprint images are compared to determine if they match does not teach or suggest comparing stored movement pattern data representing a first pattern of relative movement with a set of motion data representing a second pattern of relative movement. The Examiner has cited nothing in Paloniemi that indicates that motion data is even generated during the fingerprint input mode disclosed in Paloniemi.

In view of the above, independent claims 11, 14, and 18, are not taught or suggested by Paloniemi. In addition, dependent claims 13, 15, 19, and 22, which further limit patentably distinct claim 11, 14, or 18, and are further distinguishable over the cited reference, are also believed to be allowable over the cited reference. Allowance of claims 11, 13-15, 18, 19, and 22 is respectfully requested.

The Examiner rejected claims 3, 8, 9, 12, 16, 17, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Paloniemi in view of Gordon et al., U.S. Patent No. 6,057,540 ("Gordon"). Claims 3, 8, 9, 12, 16, 17, 20, and 21 are each dependent on one of independent claims 1, 5, 11, 14, and 18. As described above with reference to these independent claims, Paloniemi does not teach or suggest the above-quoted limitations of these claims. Gordon also does not teach or suggest the above-quoted limitations of these claims. There is also no suggestion to combine Paloniemi and Gordon.

In view of the above, dependent claims 3, 8, 9, 12, 16, 17, 20, and 21, which further limit patentably distinct claim 1, 5, 11, 14, or 18, and are further distinguishable over the

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cited references, are also believed to be allowable over the cited references. Allowance of claims 3, 8, 9, 12, 16, 17, 20, and 21 is respectfully requested.

Examiner's Response to Arguments

In the Response to Arguments section of the Office Action, the Examiner stated that:

> Applicant's arguments with respect to the rejections of claims 1-22 have been fully considered by they are not persuasive because of the following reasons: (i) Paloniemi does teach selecting a menu item based on movement data; (ii) "a first pattern" is met by "a pattern of ridges and valleys that lie across the surface of the user's fingertip" detected by the fingerprint sensor 5 when a user swipes his fingertip over the fingerprint sensor 5; (iii) Paloniemi does teach identifying a user. (Office Action at para. no. 12, pages 5-6).

As discussed above, the Examiner has cited nothing in Paloniemi that teaches or suggests that any movement data is generated in response to pressing a selection button or key, or tapping the fingerprint sensor, let alone movement data that indicates "an **amount and direction** of a second relative movement between the portable electronic device and the imaging surface," as recited in claims 1 and 5. If no such movement data is generated, it logically follows that Paloniemi also does not teach or suggest selecting a menu item "based on" such movement data as recited in claims 1 and 5.

The Examiner's statement that "'a first pattern' is met by 'a pattern of ridges and valleys that lie across the surface of the user's fingertip'" ignores claim terms used in independent claims 11, 14, and 18. These claims do not simply recite "a first pattern". Rather, each of these claims recites "storing **movement pattern** data representing a **first pattern of relative movement** between the portable electronic device and an imaging surface". The Examiner is ignoring words used in claims 11, 14, and 18, which is improper under established precedent. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The pattern of ridges and valleys of the fingerprint image in Paloniemi is not a "movement pattern," nor does the fingerprint image represent a "pattern of relative movement" between a portable electronic device and an imaging surface.

Lastly, the Examiner's statement that "Paloniemi does teach identifying a user" also ignores claim terms. None of the claims simply recite "identifying a user". Rather, claim 11

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for example, recites identifying a user "**based on the comparison of the first set of motion data to the stored movement pattern data.**" Paloniemi does not teach or suggest identifying a user, or enabling operation of a portable electronic device, **based on a comparison of stored movement pattern data representing a first pattern of relative movement with a set of motion data representing a second pattern of relative movement.**

CONCLUSION

Any inquiry regarding this Amendment and Response should be directed to Jeff A. Holmen at the below-listed telephone number or Pamela Lau Kee at Telephone No. (408) 553-3059, Facsimile No. (408) 553-3063. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to **Examiner Henry N. Tran, Group Art Unit 2674, at Fax No. (703) 872-9306** on this 28th day of March, 2005.

By
Name: Jeff A. Holmen

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